

## REMARKS

This responds to the Final Office Action mailed on November 30, 2005.

Claims 1, 10, 18, 22 are amended, no claims are canceled, and no claims are added; as a result, claims 1-24 are now pending in this application.

### About the Claim Amendments

Applicant has made a number of claim amendments to more clearly point-out the invention. These amendments were not made for reasons relating to patentability, but were made to more clearly describe the invention. In particular, these amendments include:

Claims 1, 10, 18, and 22: the occurrence of “third party” was deleted.

Claim 22: the occurrences of “the third party shopping cart application being external to an online payment service,” and “from a third party shopping cart application” were deleted. The occurrence of “in an online payment service external to a merchant web site,” was added.

### §103 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sacks (U.S. Publication No. 2002/0016765 A1) in view of Toohey (U.S. 6,405,176).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

*Discussion of Claim 1*

Claim 1 recites "the shopping cart application being external to an online payment service." The Office Action asserts,

It would have been obvious to one of ordinary skill in the art to have provided the method of Sacks to have included a third party shopping cart application external to the payment processor (of Sacks) in order to have provided the convenience of single payment transaction for all shopping among a plurality of sellers, and at the same time, allowing the sellers to receive data to update respective point of sale systems.<sup>1</sup>

The Office Action points to Toohey at col. 2, ll. 21-26 as support for this assertion. However, the cited passage does not teach or suggest claim 1's "shopping cart being external to the online payment service." The passage from Toohey states,

Thus, a particular advantage of the present invention is that electronic commerce shoppers are provided with the convenience of the single payment transaction for all shopping in the virtual mall and the virtual stores can receive data to update respective point of sale systems.<sup>2</sup>

Although Toohey's virtual stores receive data about payment transactions, Toohey's shopping carts and payment transaction processing are both performed by the virtual mall. Specifically, Toohey states, "The mall 42 preferably maintains responsibility for creating (and discarding) each electronic shopping basket."<sup>3</sup> Toohey further states, "electronic commerce shoppers are provided [by the virtual mall] with the convenience of the single payment transaction for all shopping in the virtual mall."<sup>4</sup> (Insertion added.) As a result, Toohey does not teach or suggest claim 1's "shopping cart application being external to an online payment service."

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<sup>1</sup> Toohey at col. 2, ll. 21-26

<sup>2</sup> Toohey at col. 2, ll. 21-26

<sup>3</sup> Toohey at col. 3, ll. 30-32

<sup>4</sup> Toohey at col. 2, ll. 21-26.

Claim 1 also recites “a virtual shopping cart hosted by a merchant web site.” However, the Final Office Action does not point to any passages that teach or suggest the cited feature.

For at least these reasons, Applicant submits that the combination of Sacks and Toohey does not teach or suggest each and every element of claim 1.

#### *Discussion of Claims 10 and 18*

Claims 10 and 18 each recite “the shopping cart application being external to an online payment service” and “a virtual shopping cart hosted by a merchant web site.” As noted in the discussion of Claim 1, the combination of Sacks and Toohey does not teach or suggest these features. For at least these reasons, Applicant submits that the combination of Sacks and Toohey does not teach or suggest each and every element of claims 10 and 18.

#### *Discussion of Claim 22*

Claim 22 recites “a virtual shopping cart hosted by the merchant web site.” As noted in the discussion of Claim 1, the combination of Sacks and Toohey does not teach or suggest this feature. For at least this reasons, Applicant submits that the combination of Sacks and Toohey does not teach or suggest each and every element of claim 22.

#### *Discussion of Claims 2-9, 11-17, 19-21, 23, and 24*

Claims 2-9, 11-17, 19-21, 23, and 24 each depend, directly or indirectly, on one of claims 1, 10, 18, or 22. For at least the reasons noted above, Applicant submits that the combination of Sacks and Toohey does not teach or suggest each and every element of claims 2-9, 11-17, 19-21, 23, and 24.

#### Reservation of Rights

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art. Applicant also reserves the right to pursue canceled and originally filed claims in a continuation application. Furthermore, Applicant does not acquiesce

to any of the Examiner's assertions about the claims or the cited documents and reserves the right to argue these assertions in the future.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 281-213-8980 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of January, 2006.

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